

**REMARKS/ARGUMENT****Regarding the Claims in General:**

Claims 19-54 remain pending without amendment. Claims 42-54 are presently withdrawn from consideration.

**Regarding The Allowable Subject Matter**

Applicants note with appreciation the indication that claims 19, 21-26, and 31-35 would be allowed if rewritten in independent form incorporating the limitations of their respective parent claims. Because these claims are all ultimately dependent on claim 40, which is believed to be allowable as explained below, they have been retained in dependent form pending the Examiner's further consideration.

**Regarding the Implied Election of the Method Claims for Prosecution:**

The Examiner is respectfully requested to reconsider and withdraw her ruling that only the method claims can be prosecuted on the basis that claims 42-54 are independent or distinct. The Examiner's suggestion that the claimed pipe could be constructed without curing the compound in the annular region is not realistic. According to claim 42, the axial length of the annular region is at least one-half the diameter of the outer pipe, e.g., about 1m. It is impossible to imagine any reasonable or realistic way to form a 1 m. annulus of cured compound *ex situ*, and then to install it in such a way that a reliably sealed annular region which strengthens the pipe is created within the annular space.

In short, the method and article claims are just different ways to claim a single integrated invention, and not inventions which are independent or distinct.

**Regarding the Prior Art Rejections:**

Claims 20, 27, 28, 30, 36, 40, and 41 stand rejected under 35 U.S.C. 103 as being unpatentable over Picking U.S. Patent 5,860,453 (Picking) in view of Ziu U.S. Patent 4,786,088 (Ziu) and Pool et al. U.S. Patent 6,402,201 (Pool), and claim 29 stands rejected as being unpatentable over Picking, Ziu, and Pool further in view of Stevens U.S. Patent No. 5, 474,721 (Stevens). Applicants respectfully request reconsideration and withdrawal of these rejections.

Again, applicants feel constrained to respectfully remind the Examiner that to support a rejection under 35 U.S.C. 103, there must be objective evidence in the record and an explanation of the reasons one of ordinary skill in art would have been motivated to select and combine the references, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-4 (Fed. Cir. 2002); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). ([The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references". See also: *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

As in the previous Office Action, the Examiner has simply collected the claimed features from diverse prior art, and has asserted, without the required "objective evidence of a teaching, suggestion or motivation" that it would be obvious for one skilled in the art to combine these features.

*Background of the Invention:*

A detailed discussion of the background and nature of this invention was presented in the Amendment dated November 11, 2004, and rather than repeat this, the Examiner is respectfully referred to that discussion.

*The Applied Prior Art:*

The Examiner has withdrawn the Kauffman reference applied in the previous Office Action and replaced it with Picking, but like Kauffman, Picking is not concerned about arresting the propagation of buckling. Indeed, as may be seen from col. 1, lines 28-38, Picking addresses a problem related purely to the construction of the conventional water stops used to seal the annulus of the PIP, and thereby isolate sections of insulation which become wet due to a leak in the outer pipe. The word "buckling" is not even mentioned in the patent.

Apart from this, the Examiner acknowledges that Picking does not teach selecting the materials for the inner and outer pipes according to the intended use and environment and does not teach placing a curable compound in the annular region. However, she considers that Ziu and Pool show these features and combines the respective teachings with Picking. Applicants respectfully submit that the Examiner has not provided the legally required motivation to combine the references, and can not do so in this instance *because it does not exist*.

Moreover, even the combined teachings of the references do not satisfy the terms of claim 40. Ziu relates only to various applications for thermoplastic double walled pipe (see col. 1, line 36-col. 2, line 35), but none of these are offshore pipelines. Pool, on the other hand, is concerned only with assembly of single wall pipes having wet insulation. Indeed, in her Response to Arguments, the Examiner admits that Ziu and Pool were not cited to show the capability of arresting longitudinal propagation of buckling of the outer carrier (*sic*) pipe". Thus, the fatal defect in Picking is not cured by the secondary references.

Even if a curable compound were substituted for rubber gasket 2 in Picking, the method steps recited in claim 40 would not be satisfied by the resulting combination. Claim 40 is directed to a method of manufacturing a structure which comprises inner and outer pipes and a plurality of longitudinally spaced separating elements which define an annular space between the inner and outer pipes. This is what Picking shows.

Claim 40, however, further requires assembling a double walled pipe including the separating elements:

*and also including at least one pair of sealing blocks axially spaced apart between the outer wall of the flow pipe and the inner wall of the carrier pipe . . . to define a sealed annular region within the annular space . . .*

*spacing the sealing blocks so that the axial length of the annular region is at least equal to 0.5 times the external diameter of the carrier pipe;*

*placing a curable compound in the annular region . . .*

Even if the rubber gasket in Picking is replaced by a curable compound, this only results in modification of the "separating elements" which define the annular space. There is still no pair of sealing blocks in addition to the separating elements spaced as required by the claim which define a sealed annular region within the annular space. Nor is there any disclosure, teaching or suggestion anywhere in any cited prior art for use of such a construction to arrest propagation of buckling, or for any other purpose.

In short, even if the lack of motivation is ignored, and the references are combined, the result will not render claim 40 obvious because the terms of the claim will not be met. Claim 40, as well as dependent claims 20, 27, 28, 30, 36, and 41 should therefore be allowed.

The rejection of claim 29 is improper for all the reasons stated above. In addition, the Stevens patent is even more remote as to both field of endeavor and problem being solved than the other references. Stevens relates to forming composite structures. It teaches a practitioner in the offshore pipeline art nothing about preventing buckle propagation in deep offshore pipe lines by locally strengthening the outer pipe at selected intervals in a way that permits the pipe to be laid using the reel lay technique.

In view of the foregoing, favorable reconsideration and allowance of this application are respectfully solicited.

I hereby certify that this correspondence is being transmitted by Facsimile to (703) 872-9306 addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

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Lawrence A Hoffman  
Name of applicant, assignee or  
Registered Representative

\_\_\_\_\_  
*Lawrence A Hoffman*  
Signature

\_\_\_\_\_  
March 24, 2005  
Date of Signature

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Respectfully submitted,

\_\_\_\_\_  
*Lawrence A Hoffman*  
Lawrence A Hoffman  
Registration No.: 22,436  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700